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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,116	08/10/2001	Peter R. Anderson	47079-066	6267

7590 10/23/2002

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EXAMINER
MARKS, CHRISTINA M

ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 10/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/928,116	ANDERSON ET AL.	
	Examiner	Art Unit	
	C. Marks	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 August 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10 August 2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: In figures 9-16, the lower display (12) depicts a tic-tac-toe board. The display is shown but not labeled in the picture. Figures 17-19 are also objected to because they show one of the two displays and do not label by reference number which display is actually being shown.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities: The disclosure does not describe which of the display screens is used in Figures 17-19.

The use of the trademark HOLLYWOOD SQUARES (for example see page 5, lines 14, 15, 16, and 19 as well as all other instances) has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1- 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett (WO 98/09259) in view of Orak et al. (US Patent No. 5,743,796).

Bennett discloses conducting a game of chance on a gaming machine controlled by a processor wherein an array of locations displayed on a video screen (page 3, lines 23-24) is alternatively selectable by both the player and the processor (FIG 2 and page 2, lines 26-29). A payout is awarded based upon the outcome of the game (page 2, line 29). Bennett only discloses that in the event the player wins the game by aligning three of the selected zones in a straight line, the machine will pay a prize equivalent to the sum of the prizes (page 4, lines 15-18). Bennett does not disclose the payout for the other two possible outcomes. However, it is well known in the art that there is a payout associated with all possible outcomes, such as in blackjack where a payout is positive if the player has won, neutral if the player and dealer have drawn and

negative if the dealer has won. Incorporation for a payout associated with each possible outcome is therefore well know and would have been obvious to one skilled in the art.

Orak et al. teach of a version of electronic tic-tac-toe wherein the processor can be played on multiple levels of difficulty, thus varying the probability of the processor choosing a winning strategy (Column 5, lines 36-44). The processor increases by a set percentage the ability to use winning strategy with each successive level.

Through the teachings of Orak et al. it would have been obvious to one skilled in the art at the time of invention to incorporate into Bennett et al. a processor that becomes more intelligent with each turn or level. By doing this, the game would more closely represent the actual competition between another human, as the processor's choices would appear to become more intelligent as more experience was gained. This would present a challenge to the user and keep their interest level longer as they would keep playing in pursuit of a win and the satisfaction of beating the winning strategy of the processor.

Claims 11-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoseloff (US Patent No. 6,312,334) in view of Hollywood Squares (King World Productions) further in view of Anderson Associates.

Anderson Associates teaches that branding, or the communication of the essence of a company, is important for a variety of reasons. First of all, research has shown that consumers perceive brand-name services to be of higher quality and reliability; therefore the consumer is willing to pay for the brand name. Secondly, branding can affect consumer loyalty by generating consistent and recurring sales, as well as cross-sell opportunities.

In relation to the claims 11-18, branding applies as a cross-sell of the trademarked brand name HOLLYWOOD SQUARES. In view of Anderson Associates, this would provide motivation to use the trusted brand name of HOLLYWOOD SQUARES to promote sells on other merchandise using this name, such as a gaming machine, in order to retain customer loyalty and customer willingness to pay.

Yoseloff teaches that the play of segments in a sequence that have an art recognized relationship is referred to as "thematic continuity." This would be inclusive of a contestant of player involved in a first game (for example a version of video slots) to enable advancement to another game, such as the play of a game show (Column 7, lines 48-55). Yoseloff further mentions HOLLYWOOD SQUARES (Column 8, line 4) as a possible game show to which thematic continuity could be applied.

The rules of HOLLYWOOD SQUARES are that a player competes in a game of tic-tac-toe, which is a plurality of squares in an array of locations. The player then chooses the location they desire and are presented with a trivia question and an answer to the trivia question. Based upon the answer, a symbol will be displayed at the chosen location. A first or second symbol type will be displayed based upon whether or not the player is correct. Three in a row across, up and down, or diagonally wins the game and the player is awarded a prize.

Therefore based upon the teachings of Yoseloff regarding thematic continuity and the motivation of using well-known brand names as taught by Anderson Associates, it would have been obvious to one skilled in the art at the time of invention to incorporate the rules of HOLLYWOOD SQUARES into a gaming machine environment.

Claims 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoseloff (US Patent No. 6,312,334) in view of Secret X (from THE PRICE IS RIGHT, by Kathy Greco) further in view of Anderson Associates.

Anderson Associates teaches that branding, or the communication of the essence of a company, is important for a variety of reasons. First of all, research has shown that consumers perceive brand-name services to be of higher quality and reliability; therefore the consumer is willing to pay for the brand name. Secondly, branding can affect consumer loyalty by generating consistent and recurring sales, as well as cross-sell opportunities.

In relation to the claims 19-23, branding applies as a cross-sell of the brand name SECRET X well known from the trademarked brand name game show THE PRICE IS RIGHT. In view of Anderson Associates, this would provide motivation to use the trusted brand name of SECRET X to promote sells on other merchandise using this name, such as a slot machine, in order to retain customer loyalty and customer willingness to pay.

Yoseloff teaches that the play of segments in a sequence that have an art recognized relationship is referred to as "thematic continuity." This would be inclusive of a contestant of player involved in a first game (for example a version of video slots) to enable advancement to another game, such as the play of a game show (Column 7, lines 48-55) based upon a predetermined—axiomatically random—outcome (Column 8, lines 14-16). Yoseloff further mentions THE PRICE IS RIGHT (Column 8, line 3) as a possible game show to which thematic continuity could be applied.

The rules of SECRET X from THE PRICE IS RIGHT are that a player is presented with an array of locations with a plurality of rows and columns wherein a symbol is hidden in the

second column. The contestant can then choose one or more locations from the first or third columns for placement of more symbols. The hidden symbol is then revealed and a payout is awarded if upon revelation a certain winning pattern of three in a row, either diagonally or up and down, has been achieved.

In the game as performed on THE PRICE IS RIGHT, the contestant is awarded a prize based upon a winning outcome. However, based upon the teachings of Yoseloff, in thematic continuity, the prize awarded would be a supplemental prize as the game show portion of thematic continuity is the second segment and therefore any second payouts would be supplemental to any first payouts (Column 8, lines 32-35).

Therefore based upon the teachings of Yoseloff regarding thematic continuity and the motivation of using well-known brand names as taught by Anderson Associates, it would have been obvious to one skilled in the art at the time of invention to incorporate the rules of SECRET X into a gaming machine environment.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US Patent No. 5,393,057: Electronic gaming apparatus with a bonus display which has an array of locations with trivia embodiment.

US Patent No. 6,309,300: Electronic gaming apparatus where bonus feature allows for user interaction.

US Patent No. 6,413,160: Method for playing a bonus game requiring knowledge and the presentation of questions.

US Patent No. 4,275,442: Electronic version of tic-tac-toe employing the use of a microprocessor with degree of difficulty control.

US Patent No. 4,684,136: A tic-tac-toe game in combination with trivia questions where the correct answer will result in winning the space, therefore allowing a "tic-tac-toe" based upon answering correctly.

US Patent No. 5,927,714: Slot machine that embodies a game of tic-tac-toe to determine winnings.

US Patent No. 6,334,814: Tic-tac-toe slot machine where combination of X's and O's determine the payout to the player.

US Patent No. 6,322,074: Gaming device where a plurality of user-selectable cells is associated with a character performing an answer to a question or clue and selection or characters is used to form a valid answer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Friday (7:30AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, V. Martin-Wallace can be reached on (703)-308-1148. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9302 for regular communications and (703)-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1148.

C. Marks

C. Marks
October 16, 2002

MICHAEL O'NEILL
PRIMARY EXAMINER